

## REMARKS

Claims 10-16, 18-21 and 23-25 remain for further consideration. No new matter has been added.

The objections and rejections shall be taken up in the order presented in the Official Action.

The indication that claims 16, 18-21 and 23-25 contain allowable subject matter is noted and appreciated.

1-2. Claims 10-11 currently stand rejected under 35 U.S.C. §103 for allegedly being obvious in view of the combined subject matter disclosed in U.S. Patent 5,390,342 to Takayama (hereinafter "Takayama"), U.S. Patent 5,819,167 to Lawrence (hereinafter "Lawrence") and British Patent Application 1487500 to Baker (hereinafter "Baker").

### Claim 10

Claim 10 of the present invention recites "[a] method for selecting one of several receivers of a diversity receiving system, comprising comparing the levels of control signals of the automatic gain control of the receivers, and selecting the receiver whose control signal has the lowest level." (emphasis added, cl. 10). It is alleged in the Official Action that "...Takayama teaches a method for selecting one of several receivers of a diversity receiving system (see col. 10, lines 45-53)." (Official Action, pg. 3). It is recognized that Takayama fails to disclose comparing the level of control signals of an automatic gain control of the receivers (see Official Action, pg. 3). It is then alleged that "Baker teaches comparing the level of control signals of automatic gain control of diversity receivers (see 1<sup>st</sup> paragraph, line 10-15, 23-34, & 42-45, 2<sup>nd</sup>

*paragraph, lines 46-58 & 73-81, and 3<sup>rd</sup> paragraph, lines 47-55).*" (Official Action, pg. 2). It is further alleged that Lawrence teaches detecting the levels of control signals of an automotive gain control of receivers and sending a mute signal to a receiver whose control signal has the lowest level (see col. 2, lines 24-28 and 55-61).

The Official Action contends that it would have been obvious to a skilled person at the time of the present invention "*...to make the invention adapt to include comparing the level of control signals of an automatic gain control of the receivers, and selecting a receiver whose control signal has the lowest level because this would allow for selection of a receiver with the highest quality signal.*" (Official Action, pg. 2). However, assuming for the moment without admitting that Baker discloses the technical subject matter as alleged in the Official Action, Takayama, Baker and Lawrence can not be properly combined since Takayama teaches away from such a combination. Specifically, Takayama states:

"On the other hand, when attention is drawn to the internal problem of the receiving system, there are instances where there may occur small differences in the power gain of the front ends of the two respective receiving systems. To compensate such an unevenness in the operating characteristic (amplification degree), it is conceivable to use a gain controller. **However, using the gain controller** at high frequency circuits such as a front end, etc. **is not preferable** in view of generation of noise." (emphasis added, col. 1, line 65 - col. 2, line 6).

Accordingly, the clear and unambiguous language of Takayama expressly teaches away from automatic gain control, and therefore of course teaches away from any system that utilizes information indicative of automatic gain control. Takayama clearly states that the gain controller is not desirable due to the generation of noise. As a result, a person of ordinary skill in the art would not have modified Takayama to include an AGC signal to control receiver selection in a

diversity receiving system, since Takayama expressly states that the use of automatic gain control is not desirable.

It is respectfully submitted that if the present situation is not a case of teaching away, then the entire notion of teaching away is void of any practical meaning. Teaching away does not have to be an emphatic, absolute statement that something should never be done. As known, patent applications are drafted to describe what the invention is, rather than drafting the application to recite what the invention is not and what should not be done. In the present case, when Takayama is read as a whole, the statement therein “[h]owever, using the gain controller at high frequency circuits such as a front end, etc. **is not preferable** in view of generation of noise.” (emphasis added, col. 2, lines 3-6). When read in the context of the field of radio receivers, generation of noise in any circuit is very undesirable, and electronic systems go to great lengths to reduce noise, especially when the operating speeds of the circuitry is increased. Takayama even goes on to state **“[t]herefore, it is not necessary to provide a gain controller of the front end of a system.”** (emphasis added, col. 9, lines 63-64). So this statement further teaches away from the present invention. Accordingly, it is submitted that a person of ordinary skill in the art would not have modified Takayama to include an AGC signal to control receiver selection in a diversity receiving system, since Takayama expressly states that the use of automatic gain control is not desirable and a front end gain controller is unnecessary.

Claim 20

Claim 20 recites a diversity receiver system that includes:

“a plurality of radio receivers that each provide a uniquely associated receiver output signal and a uniquely associated receiver control signal that is indicative of the amount of gain applied by said associated radio receiver to create said uniquely associated receiver output signal; and

a selection mechanism that receives said receiver control signals, and determines which of said radio receivers has applied the smallest gain correction to its associated receiver output signal, and provides a diversity receiver output signal indicative of said receiver output signal associated with the receiver that applied the smallest gain correction.” (emphasis added, cl. 20).

As set forth above, Takayama teaches away from such a system (see col. 1, line 65 - col. 2, line

6). Hence, the combination of Takayama, Lawrence and Baker is incapable of being combined, and thus incapable of rendering claim 20 obvious.

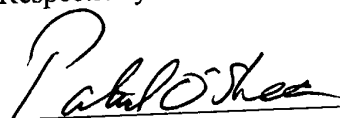
2. Claims 12-15 currently stand rejected under 35 U.S.C. §103 for allegedly being obvious in view of the combined subject matter disclosed in Takayama, Baker, Lawrence and U.S. Patent 5,777,693 to Kishigami et al (hereinafter “Kishigami”).

It is respectfully submitted that the §103 rejection of claims 12-15 is moot, and these claims are allowable since they depend either directly or indirectly from independent claim 10, which is patentable for at least all the reasons set forth above.

For all the foregoing reasons, reconsideration and allowance of claims 10-16 and 18-21 and 23-25 is respectfully requested.

If a telephone interview could assist in the prosecution of this application, please call the undersigned attorney.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Patrick J. O'Shea", written over a horizontal line.

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